

**REMARKS/ARGUMENTS**

This Amendment is responsive to the Notice of Non-Compliant Amendment mailed on October 30, 2008. Entry of this Amendment is requested.

In this amendment, Applicant's have separately listed all claims, per the Notice of Non-Compliant Amendment. Applicants note however, that aggregating canceled claims is allowed under MPEP 714(c)(1), and as per the Sample Format for Revised Amendment Practice found on the USPTO website. However, the claims have been separately listed in the present amendment in order to expedite prosecution.

Claims 1-2, 4-5, 7, 9, 11-20, 36, 39-41, and 43-44 are pending in the present application. In the Office Action, claims 1-7, 9-22, and 34-43 have been rejected. Claims 3, 6, 21, 22, 34, 35, 37, 38, and 42 have been canceled. Claim 1 has been amended to incorporate canceled claims 3, 6, and 42. Claims 4, 7, 11, 13, 40, and 43 have been amended to fix their dependencies. Claim 44 has been added. Support for newly added claim can be found in paragraph [0070] of the specification. No new matter has been added. Reconsideration of the rejected claims is respectfully requested.

The amendment to claim 1 *does not raise new issues, because it is the same as prior dependent claim 42*. Entry of this amendment is requested since it reduces issues for appeal.

**I. 35 USC 103**

Claims 1-2, 4-5, 7, 9, 11-20, 36, 39, and 43 are rejected as obvious over Corrin (US 2002/0035527 A1) and Longo. This rejection is respectfully traversed.

**A. *current performance planning table***

Claim 1 has been amended to incorporate canceled claims 3, 6, and 42. Obviousness has not been established for independent claim 1 or any claims that are dependent thereon, since all limitations in the claims are not taught or suggested by the prior art. "All words in a claim must be considered in judging the patentability of that claim against the prior

art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.  
For example, the cited art does not disclose the limitations of now cancelled claim 6, which have been incorporated into independent claim 1:

providing a current performance planning table, wherein said table allows for assessing approximate current yield and total return information in order to determine which holdings of said assets provide cash flow versus growth required to meet said in-retirement goals

In the prior amendment filed January 31, 2008, the Applicants argued (in reference to now cancelled claim 6) that obviousness has not been established, since all limitations in the claim are not taught or suggested by the prior art. However, in the Office Action dated April 24, 2008, the Examiner did not respond to the arguments. As noted by MPEP § 707.07(f):

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Pursuant to MPEP § 707(f), Applicants request that the Examiner answer the substance of any arguments made for any rejections that are repeated in subsequent Office Actions.

As recited in the previous Office Action, although Examiner argues that Corrin at lines 081-0141 discloses the claimed limitations, in fact that section of Corrin teaches a Retirement Track Chart and Table that compare previous account balances and balances needed to meet requirement goals (See paragraph 0085 of Corrin). The chart and table appear to utilize and display total account value for different time points beginning with the first reported account value (See paragraph 0137 of Corrin). Nothing in the chart and table, however, disclose a table that allows for assessing approximate current yield and total return information to determine which holdings provide cash flow versus growth (See Fig. 7 of Application). Thus, Corrin and Longo do not teach independent claim 1, or the dependents thereon.

***B. each asset's annual income, 1-year and 5-year total returns, and current value***

Furthermore, the cited art does not disclose the limitation of claim 1 "wherein said current performance planning table includes information on each asset's annual income, 1-year and 5-year total returns, and current value." Applicant's argued that the cited references do not disclose such a limitation (in reference to now-cancelled claim 42) in the amendment filed on January 31, 2008. The Examiner did not respond to those arguments in the Office Action. In page 11 of the Office Action, the Examiner states that the limitation regarding information on a current performance planning table is "a descriptive non-functional element" and fails to give the claim patentable weight.

The Applicants respectfully disagree. Section 2106.01 of the MPEP defines "nonfunctional descriptive material" as:

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter and should be rejected under 35 U.S.C. 101. Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter.

As recited in the present application, "[t]he invention provides the customer with information that allows the customer to make decisions that fit their cash flow needs." See paragraph [0070]. The above claim limitation is entirely functional, since it provides the customer the information needed to forecast and make investment decisions. As recited in paragraph [0071], "[a]n objective of the preferred embodiment of the invention is to help customers create a personalized cash flow withdrawal plan by analyzing their existing assets and using a variety of investment products, and to provide more in depth and specific investment advice." Different information provided (for example, 1 year or 5 year returns) could lead to different performance metrics, and thus to different investment decisions. There is a "functional interrelationship" between the claim limitation and the forecast created by the claimed method. Therefore, the claim language is not a "descriptive non-functional element," and must be

accorded patentable weight. Furthermore, claim 1 is a method claim, and the step of "providing a current performance planning table" must be accorded patentable weight.

**C. *findings overview report***

Corrin in view of Longo does not disclose providing a findings overview report based on said analysis, wherein the findings overview report include[s] the in-retirement goals, and the likelihood that the in-retirement goals will be met if the in-retirement income stream withdrawal strategy is followed, and the findings overview report further including an asset drawn down schedule which shows a predicted end of year account balance for each of the plurality of different types of customer accounts if the in-retirement income stream withdrawal strategy is followed

(emphasis added) It is respectfully submitted that the overview report which shows a predicted effect of following the specific in-retirement income stream withdrawal strategy on the different types of accounts, in combination with the other elements of the claims provides a very significant advantage to the customers. Aspects of an embodiment of a findings overview report are shown in Fig. 4 of the present application, and discussed at paragraphs 93-96 of the present application

The Examiner argues that Corrin in view of Longo discloses a report with "meaningful saving goals, the effectiveness of the investor's current strategy, investment performance expectations, investment guidance encompass the in-retirement goals and asset drawn down schedule." See page 13 of the Office Action. This is an incorrect assumption. Paragraphs [0010-0011] cited by the Examiner disclose generalities, but not an "asset drawn down schedule" as recited in claim 1. An "asset drawn down schedule" can be a "bar chart [that] shows the amounts each of taxable (bottom) 209, tax deferred (middle) 210, and tax free (top) 211 withdrawals for the customer's end of year account balance 212 versus the customer's in-

retirement age." See paragraph [0095] of the present application. The cited passages of Corrin do not disclose any such schedule.

Corrin and Longo do not disclose end of the year account balances on a findings overview report, as claimed. Paragraphs [0095-0096] of Corrin disclose the calculation of income streams (i.e. total yearly withdrawal amounts), but not the calculation of end of year account balances for each of a plurality of different types of customer accounts as required by the asset drawn down schedule. Moreover, as described above, such data can be used in forecasting and investment strategy. As such, it is not just "information/data which can easily be included in an investment advisory report of Corrin without altering/changing the system of Corrin" as claimed by the Examiner on page 4 of the Office Action. Corrin is drawn to a different investment strategy than the claimed method. Changing the "information/data" would change the strategy, and thus Corrin teaches away from such modifications. As such, independent claim 1, and the dependents thereon, are allowable, at least for this reason.

**CONCLUSION**

The cited art fails to teach or suggest not one or two, but at least three limitations in the broadest claim. Accordingly, there are many more reasons why the claims are patentable rather than unpatentable.

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Adam J. Pyonin  
Reg. No. 57,301

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
AJP:km  
61686293 v1